



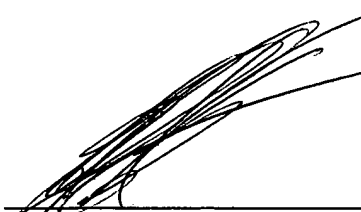
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0879-0372P	
	Application Number 10/055,379-Conf. #007570	Filed January 25, 2002	
	First Named Inventor Mikio WATANABE		
	Art Unit 2155	Examiner K. T. Bates	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>29,680</u></p> <p> _____ Signature _____ Michael K. Mutter Typed or printed name _____ (703) 205-8000 Telephone number _____ June 26, 2006 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Docket No.: 0879-0372P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mikio WATANABE

Application No.: 10/055,379

Confirmation No.: 7570

Filed: January 25, 2002

Art Unit: 2155

For: METHOD AND SYSTEM FOR
TRANSMITTING IMAGE

Examiner: K. T. Bates

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached four (4) Sheets.

The Examiner has made clear errors in applying the prior art in rejecting claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over *Wright et al.* (USP 6,721,802) in view of *Ward* (USP 6,784,924).

**The Examiner has Failed to Establish Prima Facie Obviousness
by Failing to Provide References that Teach or Suggest All of the Claim Elements**

The Examiner has made clear error in maintaining that *Ward* discloses certain elements recited in the claims. Applicant maintains that the teachings of *Wright et al.* and *Ward* are insufficient to anticipate the present invention.

In support of the Examiner's rejection of claim 1, the Examiner admits that *Wright et al.* fails to teach or suggest the newly added claim elements. The Examiner relies on the teachings of *Ward* to cure the deficiencies of the teachings of *Wright et al.* asserting *Ward* discloses enabling selection of one of the plurality of menu buttons, wherein each of the plurality of menu buttons corresponds to one of a plurality of services (col. 3, lines 10-14), including an image storage service, an image print service (col. 3, lines 28-29), and a mobile phone service (col. 2, lines 5-11). The Examiner further asserts that *Ward* discloses enabling selection of a menu update button, which updates information associated with the plurality of menu buttons (col. 2, lines 62-67). Applicant respectfully disagrees with the Examiner's interpretation of the teachings of *Ward*.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The disclosure of *Ward* is directed to a camera receiving a network configuration file enabling the camera to transmit images from an electronic still camera over a network without connecting to a personal computer. At col. 3, lines 26-28, *Ward* merely discloses that the selected image files may be tagged with a code indicating which service is requested.

In contrast, the present invention of claim 1 recites “...enabling selection of one of a plurality of menu buttons, wherein each of the plurality of menu buttons corresponds to one of a plurality of services including an image storage service, an image print service, and a mobile phone screen service.” There is no discussion in *Ward* that is directed to any menu buttons. *Ward* simply discloses tagging an image file with a code that indicates which service is requested. There is no disclosure in *Ward* that is directed to how the services are requested.

Further, the Examiner relies on col. 2, lines 5-11 to disclose a menu button corresponding to mobile telephone screen service. However, at this citation, *Ward* merely discloses that the transmission of images may occur immediately after the pictures are taken if the camera has a built-in cellular phone modem. These teachings are insufficient to teach or suggest the claim element of a menu button corresponding to a mobile telephone screen service.

Finally, the Examiner relies on col. 2, lines 62-67 to teach enabling selection of a menu update button, which updates information associated with the plurality of menu buttons. However, at this citation, *Ward* discloses the initial download of the configuration file in the camera. There is no disclosure in *Ward* regarding updating any menu button information. Further, there is no disclosure in *Ward* regarding enabling selection of a menu update button, which updates information associated with the plurality of menu buttons.

As such, Applicant maintains that *Ward* fails to cure the deficiencies of the teachings of *Wright et al.* As neither of the references, either alone or in combination, assuming these references are properly combinable which Applicant does not admit, teach or suggest all of the claim elements, Applicant respectfully submits that claim 1 is not obvious over the references as cited by the Examiner. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-12 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1. It is further respectfully submitted that claim 13 includes elements similar to those discussed above with regard to claim 1 and thus claim 13, together with claims dependent thereon, are not obvious over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 26, 2006

Respectfully submitted,

By 

Michael K. Mutter

Registration No.: 29,680

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant